

REMARKS

1. Posture of the case

Claims 1-21 were originally presented in the application filed October 23, 2003. In a preliminary amendment, filed September 12, 2004, claims 1-3, 5-9, 12-17, and 19-21 were amended to correct informalities and dependencies.

In a non-final Office action of March 28, 2007, claims 15-21 were rejected under 35 USC. 101 on grounds that the claimed invention is directed to non-statutory subject matter and claims 1-21 were rejected under 35 USC. 102(b) as being unpatentable over US patent 6,151,643 (Cheng).

In Reply A, filed June 28, 2007, Applicant amended claim 15 to overcome the 101 rejection and submitted amendments and arguments to claims 1, 8 and 15 to overcome the 102(b) rejections.

In a preliminary amendment of August 8, 2007, Applicant canceled all method claims, which were claims 1-7.

On August 20, 2007, a final rejection (the Final Office Action") maintained the prior rejections.

Applicant appealed the rejection in a Notice of Appeal filed November 19, 2007.

Particular arguments were presented in an Appeal Brief of January 21, 2008, for claims 8, 13, 15 and 20.

In a non final Office action of April 9, 2008, claims 8 and 10-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of US 200210158900 A1 ("Hsieh").

In a reply, filed July 9, 2008, Applicant traversed, amended claims to put the claims in better form and to ensure proper antecedent basis, and canceled claims 9 and 16.

The present, final Office action of September 15, 2008, rejects pending claims under the same art, stating that "Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. ("Cheng", US 6,151,643) in view of Hsieh et al. ("Hsieh", US 200210158900 A1)." Applicant assumes Examiner meant to reject claims 8, 10-15, and 17-21, rather than claims 1-36.

2. Rejection of claims 8 and 15

Independent claims 8 and 15 concern deployment of customized software by post-load images, where a server has post-load images stored for various custom combinations of software and hardware, where a user indicates to a server the user's client hardware and desired software applications, and where a server responsively delivers the selected combination in the form of a post-load image, including drivers and other system operating parameters.

The main rejection relies upon Cheng for teaching about storing arrays of software and deploying the software and relies upon Hsieh for teaching about post-load images.

Attorney England spoke with Examiner Kumar by telephone on October 14, 2008, to explore remarks on page 10 of the final rejection. Examiner Kumar suggested that a narrower limitation regarding "post-load image" is called for and indicated that a limitation about delivering "only" post-load images would more particularly point out how the present invention differs from the prior art. See discussion further below regarding claim amendments herein.

Custom nature of post-load images deployed

Examiner Kumar and Attorney England also explored how to convey more particularly the notion of custom software deployment. Attorney England argued that the claims convey the custom nature of the post-load image deployed. Examiner Kumar indicated, however, that he was not persuaded.

Examiner Kumar advised including limitations about the server automatically evaluating the purchaser's profile and responsively presenting customized choices for the user to select among. However, this matter is particularly recited in dependent claims 13 and 20, which Applicant herein incorporate, respectively, into claims 8 and 15. (For background, see also, specification page 9, line 10, through page 10, line 12.) The present Office action rejects these dependent claims. Applicant submits this rejection is unfounded.

Combining "post-load images" and automated deployment

Applicant has also pointed out previously that Hsieh teaches away from its combination with Cheng by stating that automated deployment is not effective for situations in which computers need to be customized to accommodate individual requirements of varied users. See Applicant's Reply of July 9, 2008, pages 12-13 (pointing to Hsieh paragraphs 8 and 9). The present Office action maintains the same rejection. Present Office action, pages 4 and 10. Applicant submits this rejection is improper.

In particular, the present Office action argues that Hsieh is used to make a case for obviousness for including post-load images in Cheng, and all the other elements of the claim are clearly anticipated by Cheng, and the issue of automated deployment was not the part of citation used from Hsieh in the rejection. *None of this addresses Applicant's point*, which is that teaching A of a first reference cannot be properly combined with a second reference's isolated teaching B when the second reference *also teaches that B does not fit with A*. MPEP 2143.01 IV and VI.

The Office action relies upon Hsieh for post-load images and Cheng for automated deployment related features. But Hsieh teaches that post-load images do not fit with automated deployment. Therefore, it is improper to combine post-load images as taught by Hsieh with automated deployment features.

Conflating "new programs" and "updates"

Further, Applicant has also pointed out previously that Cheng does not teach the aspect recited in claims 8 and 15 regarding suggesting new programs and that the rejection conflates "new programs" with "updates." See Applicant's Reply of July 9, 2008, pages 15-16. The present Office action, pages 10 and 11, item C, maintains the same rejection, which Applicant submits is without grounds.

The analysis in the present Office action regarding claim 13 addresses this point, although Applicant respectfully submits the analysis is incorrect. It is telling that *the rejection in this regard asserts claim 13 has language that is not what is actually*

recited by the claim. The present Office action (page 7, last paragraph of discussion regarding claim 13) ¹ *continues to misquote* claim 13 (and, by reference, claim 20) by reciting "a list of suggested updates for the software programs." *This is not what claim 13 and claim say!*

In particular, the present Office action argues on page 11 that this matter of the difference between "new programs" with "updates" is addressed "under claim 8 and 15," which Applicant takes to be a reference to pages 2-4 (for claim 8) and page 8 (for claim 15). However, page 8 of the present Office action merely points to the discussion of claim 8 at pages 2-4. And the analysis at pages 2-4 does nothing to address Applicant's point.

On page 7, the Present Office action remarks that Cheng teaches a sample user display of applicable software updates in which a first order (i.e. "Quicken 5.0") and a second order (i.e., "Update from 5.0 to 5.0F") are displayed side-by-side. However, Applicant wishes to again point out that *this merely serves to reinforce Applicant's distinction.*

Claim 12 in the present application recites "presenting . . . a list of suggested updates for the software programs of the first order" (emphasis added). In order to give full weight to all the words of the claims, the term "software program" must be construed as different from "software updates." ² Consequently, "software updates," as recited by claim 12 and taught by Cheng are not "suggested software programs . . . in addition to those of the first order," as recited in claim 13. However, the Final Office Action conflates the two by misquoting claim 13. The present Office action, page 7, last paragraph of discussion regarding claim 13 states that claim 13 (and, by reference, claim 20) recites "a list of suggested updates for the software programs." This is not what claim 13 says.

¹ In the same manner as the prior Office action (page 8, last paragraph).

² See, for example, Comark Communications Inc. v. Harris Corp., 156 F. 3d 1182, 48 USPQ2d 1101, 1105 (Fed. Cir. 1998).

Amendments herein

Applicant's Reply of July 9, 2008, pages 14 and 15, argued that the combination of Cheng and Hsieh do not teach or suggest the particular "pre-built, post-load images" as recited in claim 8 (and claim 15). (Applicant hereby reasserts this argument without repeating it herein, since it is of record.) The present Office action responds on page 10 that "this does not preclude other types of images in the array." Applicant submits that this response does not address the argument.

That is, if Cheng and Hsieh are the references relied upon for the rejection, but they do not teach what is claimed, then it is irrelevant whether Cheng and Hsieh teach something else that could theoretically also be included with the claimed features. Stated another way, if they do not teach what is claimed, then it is irrelevant whether Cheng and Hsieh teach something other than what is claimed.

Nevertheless, merely in order to expedite allowance of the application and without disclaiming the right to pursue claims to the broader subject matter, including that matter discussed herein above, Applicant herein incorporates the limitations of claim 13 into independent claim 8 and also amends to still further narrow. (Applicant herein also amends claim 15 in similar fashion to incorporate claim 20 and to also still further narrow claim 15.) That is, as Examiner Kumar suggested Applicant also herein amends claims 8 and 15 to recite "sending the selected image, the image sent being limited to the pre-built, post-load image."

3. Claims 10-12, 14, 17-19 and 21

Applicant submits that dependent claims 10-12, 14, 17-19 and 21 are allowable at least because they depend upon respectively allowable independent claims 8 and 15.

REQUEST FOR ACTION

For the above reasons, Applicant submits that the invention defined in claims 8, 10-12, 14-15, 17-19 and 21 are allowable. Applicant requests that Examiner grant allowance and prompt passage of the application to issuance.

Respectfully submitted,

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